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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,138	03/06/2001	Robert Olan Keith JR.	ABREAU-00102	6011

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HAVERSTOCK & OWENS LLP  
162 NORTH WOLFE ROAD  
SUNNYVALE, CA 94086

EXAMINER
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NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 03/16/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/801,138

Applicant(s)

KEITH, ROBERT OLAN

Examiner

CamLinh Nguyen

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. Claims 1 - 96 of this application conflict with claims 1 - 40 of Application No. 09/801,072. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
  2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
  3. Claims 1 – 96 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 - 40 of copending Application No. 09/801,072. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.
- The following table shows the claims in '138 that are rejected by corresponding claims in '072

Art Unit: 2171

Claims comparison table

	'138	'072
Claims	1, 2, 49, 50, 73, 74	1, 36, 37,
	3, 53, 78	5
	4, 54, 75	2
	5, 51, 76	3
	6, 52, 77	4
	7, 55, 79	6, 39,
	8, 56, 80	7
	9, 57, 81	8, 38
	10, 58, 82	9
	11, 59, 83	10, 40,
	12, 60, 84	11
	13, 61, 85	12
	14, 62, 86	13
	15, 16, 39, 40, 63, 64, 87, 88	27
	17, 41, 65, 89	28
	18, 42, 66, 90	29
	19, 43, 67, 91	30
	20, 44, 68, 92	31
	21, 45, 69, 93	32
	22, 46, 70, 94	33

23, 47, 71, 95	34
24, 48, 72, 96	35
25 & 26	14
27	17
28	18
30	16
31	19
32	20
33	21
34	22
35	23
36	24
37	25
38	26
39 & 40	14 & 27
48	35

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2171

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 96, are rejected under 35 U.S.C. 102(e) as being anticipated by Witek et al (U.S. 6,253,188).

♦ As per claim 1, 15, 25, 39, 49, 63, 73, 87,

Witek teaches a method of performing a research task within a searchable database comprising:

- “Utilizing a selective one or more search methodologies including keyword search, hierarchical search...” See Fig. 1, 7,10. In particular:
  - o “A search module” corresponds to the search engine that implemented in Fig. 1.
  - o “A search criteria” corresponds to arguments or selections that user enters in Fig. 7, element 112.
  - o “A searchable database” corresponds to database server (Fig. 1, element 20, col. 9, lines 53 – 55)
  - o “One or more matching items” corresponds to the results that sent to user (Fig. 7, element 126 – 128).
  - o “The search module includes keyword search” See Fig. 10, element 148, col. 29, lines 28 – 34.
  - o “A hierarchical search” corresponds to “category search” because the categories include subcategories that organized in a hierarchical order. See Fig. 4, col. 31, lines 4 – 11.

- “A dichotomous key search” See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10, element 144 – 146. As defined in the Specification a “dichotomous key search” is used to instruct users given in an answer or question dialog, often yes or no answer (Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the “dichotomous key search”.
- “A subsequent search” corresponds to a second or third loop of search based on the result. See col. 12, lines 28 – 43.
- ◆ As per claim 2 – 3, 6, 16, 28, 53, 78,
  - “The search module further comprises a parametric search capability” See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29.
  - “The utilized search methodology is the parametric search, the search criteria is one or more set parameters, and further wherein the parameters are set by a user” See Fig. 10, elements 154, 158, 160, 142, col. 30, lines 10 – 29. As shown in Fig. 10, a user can set the values for parameters such as date, the range price, or number of room.
- ◆ As per claim 4, 29, 54, 74 – 75, 88,
  - “The search criteria is one or more keywords input by a user” See Fig. 10, element 148, col. 29, lines 28 – 34.
- ◆ As per claim 5, 30, 50 – 51, 64, 76,

- "The utilized search methodology is the hierarchical search, the search criteria is selected one of a list of one or more directory items" "A hierarchical search" corresponds to "category search" because the categories include subcategories that organized in a hierarchical order. See Fig. 4, 6 – 7, col. 31, lines 4 – 11.
- ◆ As per claim 6, 26 – 27, 40, 52, 77,
  - "The utilized search methodology is the dichotomous key search, the search criteria is a selected one of two binary items" See Fig. 3, element 70, col. 16, lines 27 – 50, Fig. 10, element 144 – 146. As defined in the Specification a "dichotomous key search" is used to instruct users given in an answer or question dialog, often yes or no answer (Specification, page 18, lines 6 – 8). In fig. 10, Witek also gives the users the options of answer questions by checking the boxes. Therefore, this search option is corresponding to the "dichotomous key search".
- ◆ As per claim 7, 20, 31, 44, 55, 68, 79, 92,
  - "The searchable database is distributed into more than one physical location" See Fig. 1, element 20, col. 9, lines 53 – col. 10, lines 5, col. 25, lines 37 – 44.
- ◆ As per claim 8 – 10, 17 – 19, 32 – 34, 41 – 43, 56 – 58, 65 – 67, 80 – 82, 89 – 91,
  - "The steps of utilizing the search methodologies are performed by a server" See Fig. 1, 5A, col. 25, lines 13 – 33.
  - "Establishing an Internet connection with the server to utilize the search methodologies" See Fig. 5a, element 14, 24, col. 21, lines 15 – 20.
- ◆ As per claim 11 – 12, 21 – 22, 35 – 36, 45 – 46, 59 – 60, 69 – 70, 83 – 84, 93 – 94,



Art Unit: 2171

- "The searchable database is formatted in a directory tree structure" See Fig. 4, col. 18, lines 1 – 32.
  - "The directory tree structure includes nodes ... branches" See fig. 4. Each category corresponds to a node. All nodes are linked together.
  - "The collection of related data for a particular node is displayed in an encyclopedia like format, wherein the encyclopedia like format includes text, graphics, and links to related topics" See Fig. 8 – 10, col. 23, lines 44 – 48, col. 24, lines 10 – 16.
- ♦ As per claim 13 – 14, 23 – 24, 37 – 38, 47 – 48, 61 – 62, 71 – 72, 85 – 86, 95 – 96,
- "Maintaining the node by appropriately adding and deleting data to and from the node" See col. 50, lines 4 – 15.
  - " The step of maintaining the node is performed by a node owner" See Fig. 14, col. 50, lines 4 – 15. " A node owner" corresponds to the system administrator.

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 - 96 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - Monberg et al (U.S. 6,523,021) discloses a business directory search engine.
  - Vanderpool et al (U.S. 5,781,773) discloses a method for transforming and storing data for search and display and a searching system utilized therewith.


Art Unit: 2171

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is 305-1951. The examiner can normally be reached on Monday - Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308- 1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. A new official fax number, that will effect in December 1<sup>st</sup>, 2003, is 703 -872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

Cam-Linh Nguyen  
Art Unit 2171

  
WAYNE AMSBURY  
PRIMARY PATENT EXAMINER

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